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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,411	12/12/2001	Olivier Furon	81927DAN	3716

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EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/021,411

Applicant(s)

FURON ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/12/2001 and 5/13/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-15 have been examined.

Claim Objections

Claims 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Whereas claim 1 recites, "transferring at least one original image from a digital image database to the multimedia device," claim 8 recites, "the original digital image from a digital image database is simply consulted on the multimedia device without transferring the said image to the said multimedia device." Thus, claim 8 contradicts claim 1, rather than further limiting the previous claim.

Claim 9 is objected to because of the following informalities: Extraneous commas should be deleted, so that in the first and second lines, "the, at least one, original digital image" should be "the at least one original digital image". Appropriate correction is required.

Claim 10 is objected to because of the following informalities: Extraneous commas should be deleted, so that in the fourth line, "the, at least one, original digital image" should be "the at least one original digital image". Also, in the third line, "comprises" should be "comprise", since the subject of the verb, "navigation parameters", is plural. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claim 1 and a possible interpretation of claim 14, does not reasonably provide enablement for another interpretation of claim 14, which is rejected as ambiguous (see below). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with claim 14. On the interpretation that the preferred kiosk has, on-site, a portable terminal equipped with a display screen, and this is used to reconstitute the work order, by printing or otherwise creating an embodiment of the chosen digital image, it is not explained how the portable terminal with its display screen is involved in reconstituting the work order.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites, "wherein the work order for the at least one chosen digital image is reconstituted at the preferred kiosk on a portable terminal equipped with a display screen." It is not clear what this means. On a first interpretation, the preferred kiosk has, on-site, a portable terminal equipped with a

display screen, and this is used to reconstitute the work order, by printing or otherwise creating an embodiment of the chosen digital image. On a second interpretation, the kiosk receives the work order from a user using a portable terminal equipped with a display screen. The second interpretation has the advantage of being supported by the specification (page 4, lines 16-19) and drawings (Figures 1 and 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 3, 4, 5, 6, 10, 11, 12, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (U.S. Patent 6,833,861) in view of Reifel et al. (U.S. Patent 7,013,288), Sandhu et al. (U.S. Patent 6,980,812), and official notice.

As per claim 1, Matsumoto discloses a method of sending a photographic order from a digital camera, the method comprising: automatically accessing on a digital camera navigation parameters reflective of a geographic location of the digital camera (column 6, line 49, through column 7, line 29), and transmitting from the digital camera to a processing center, photographic order including information on a specific form and type of work to be executed from the chosen at least one digital image (Abstract; column 3, lines 23-48); and delivering on the screen of the digital camera a list of fixed kiosks or other printers, presumably compatible with the navigational parameters (e.g., GPS, as disclosed) of the digital camera (column 6, line 49, through column 7, line 23); and choosing on the digital camera, from the list of kiosks and/or printers, a preferred printer/kiosk (column 6, line 49, through column 7, line 23); and automatically sending, from the digital camera to the preferred kiosk/printer, a work order for the work to be executed in the specific form on the at least one digital image (column 3, lines 23-48). Matsumoto does not disclose transferring at least one digital image from a digital image database to the multimedia device, instead disclosing using a digital camera rather than a multimedia device of another kind, but, it is known to transfer images from an image database, such as the image database of a digital camera, to a multimedia device such as a cell phone, and Reifel in particular teaches doing so for further transfer to a print house for ordering prints (column 6, lines 25-42). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transfer at least one digital image from a digital image database to the multimedia device, for the obvious and implied advantage of transferring the image for printing if the

digital camera, or other apparatus containing the original digital image, did not have its own capacity for long-distance communication, but could transfer data through a coupled cellular phone or other multimedia device.

Matsumoto does not expressly disclose choosing the at least one original digital image from the multimedia device, but it is well known to choose images for printing or reproduction, etc., as taught, for example, by Reifel (column 8, lines 21-23). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to choose the at least one original digital image from the multimedia device, for the obvious advantage of printing or otherwise working on desired images, but not images for which this is not desired.

Matsumoto does not disclose a transport vehicle, but official notice is taken that transport vehicles (automobiles, tourist buses, bicycles, etc.) are well known, and such devices as cell phones and cameras are often carried and used in transport vehicles. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the photographic order to be sent from a transport vehicle, for the obvious advantage of taking or transmitting pictures using a camera that is on a vehicle, which is especially obvious in consideration of Matsumoto's teaching of a digital camera being mobile, with a GPS receiver for determining its position.

Matsumoto does not disclose transmitting a list of the navigation parameters, or even a simple location parameter, to a processing center, but Sandhu teaches transmitting location information from a wireless device to a processing center (server)

to deliver information on at least one business able to satisfy the customer's wants (Abstract). Hence, it would have been us to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit a list of navigation parameters, for the obvious and implied advantage of finding a business within a convenient distance of the user.

As per claim 2, Matsumoto does not disclose that an invoicing is done automatically from the processing center, by debiting an electronic account of a user, but official notice is taken that it is well known to automatically invoice for a product or service by debiting an electronic account of a user. Hence, it would have been us to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of readily obtaining payment.

As per claim 3, Matsumoto discloses a voice transmission device (column 4, lines 54-60), and Sandhu discloses a multimedia device that provides audio output (column 5, lines 49-65). Matsumoto does not disclose that the multimedia device orally alerts a user as soon as the work to be executed is available in the preferred kiosk/printer, but official notice is taken that it is well known to use an aural signal (live voice, recorded voice, buzzer, etc.) to orally alert a user as soon as a process is finished or an item available. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a system of voice recognition integral with the multimedia device to orally alert a user as soon as the work to be executed was available in the preferred kiosk/printer, for the obvious

advantage of letting the user know when his prints or other ordered work in specific form were available.

As per claims 4, 5, and 6, Reifel teaches transferring a digital image from an image capture device to the multimedia device (cellular phone), the image capture device being a digital camera, the digital camera qualifying as a portable terminal (paragraph 6, lines 20-42). Hence, this would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious and implied advantage set forth with regard to claim 1 above.

As per claim 10, Matsumoto discloses that the navigation parameters transmitted by the multimedia device to the processing center comprise, in addition to the specific form of the type of work to be executed on the at least one original digital image, at least the camera's geographic position at the moment of transmitting the parameters (column 6, line 49, through column 7, line 23), which would be the vehicle's geographic position, in the case of the digital camera being transported on a vehicle.

As per claim 11, Matsumoto discloses that the work order for the at least one chosen original digital image is reconstituted at the preferred printer in a visual form affixed to a material medium (e.g., column 8, lines 17-29).

As per claim 12, Matsumoto discloses that the work order for the at least one chosen original digital image is reconstituted at the preferred printer in the form of a photographic paper medium (column 3, line 65 through column 4, line 19).

As per claim 13, Matsumoto discloses that the work order for the at least one chosen original digital image is reconstituted at the preferred printer/facility in the form of a compact disk (column 4, lines 49-53).

As per claim 15, Matsumoto does not disclose that the preferred kiosk/printer is placed in a service station, although it is arguable that the photo shop, for example (e.g., column 7, lines 19-23) qualifies as a service station in that it provides services. Moreover, official notice is taken that it is well known for various vending machines, ATM's etc. to be available at service stations (in the sense of stations where one may buy gasoline and other car-related products and services). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the preferred kiosk/printer to be placed in a service station, for the obvious advantages of making the kiosk/printer convenient to users in the vicinity (by analogy to Matsumoto, column 7, lines 8-23), and obtaining an additional source of revenue for the service station owner/manager.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto, Reifel, Sandhu, and official notice as applied to claim 1 above, and further in view of Naito et al. (U.S. Patent 6,628,417). As per claim 8, Matsumoto does not disclose that the original digital image from a digital image database is simply consulted on the multimedia device without transferring said image to the multimedia device, but Naito teaches storing image data at image servers distinct from the client devices from which orders are placed, without the full image necessarily being sent to the client

device (Abstract; Figure 1; column 7, lines 13-34). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the original digital image simply consulted in this way, for at least the obvious and implied advantage of not attempting to display the full image on a low-resolution multimedia device not equipped to display it at full resolution.

As per claim 9, Naito teaches having at least one chosen digital image transferred directly from a server to a processing center/designated print server (*ibid.*). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transfer the at least one chosen digital image directly from a server to the processing center, for at least the obvious and implied advantage of having the image printed where desired, the image being stored at a server.

Because claim 14 is so indefinite and incomplete, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of the claim. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); *Ex parte Brummer*, 12 USPQ 2d, page 1654; and also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Matsumoto et al. (U.S. Patent 6,833,861), discloses most limitations of claim 1, as set forth above; other elements are taught by Reifel et al. (U.S. Patent 7,013,288), or by Sandhu et al. (U.S. Patent 6,980,812), or are obvious and well known, but neither Matsumoto nor any other prior art of record discloses or reasonably suggests that the at least one chosen image is transferred from an image server to the vehicle's multimedia device. Image servers are known (as taught, for example, by Naito et al., U.S. Patent 6,628,417); one can download images from them, but there is no teaching or motivation in the prior art of record to suggest combining image servers with the method of Matsumoto to transfer the at least one image from an image server to the vehicle's multimedia device. Matsumoto is concerned with transferring printing images which a user takes with his digital camera from the camera to a printer; the digital camera is not regarded as an image server, and if one wanted to print a chosen image from an image server (as in Naito), there is no apparent motive in the prior art of record or the knowledge generally available to one of ordinary skill in the art to involve a mobile multimedia device, and locate a suitable fixed kiosk.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Konishi (U.S. Patent 6,915,119) discloses a telephone and a transmitting method for the telephone (note especially column 3). Calaway (U.S. Patent 7,092,116) discloses a method and system for processing an annotated digital photograph using a composite image.

Schena et al. (U.S. Patent Application Publication 2001/0003177) disclose printed medium-activated interactive communication. Endsley et al. (U.S. Patent Application Publication 2006/0139474) disclose a system and camera for transferring digital images to a service provider. Vock et al. (U.S. Patent Application Publication 2007/0110278) disclose a mobile image capture system.

Padgett ("Architect's Two Worlds Collide, Form New Firm"), the anonymous article, "D-cam Image Transmission through Cellular Phones," and Jerome ("Office Networking") disclose transmitting images from a digital camera via a cellular phone, laptop, or such device. The anonymous article, "The Prints of Digital Photography," discloses kiosks to which digital camera users can upload pictures and from which they can obtain prints.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number

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for the organization where this application or proceeding is assigned is 571-273-8300.

Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen

NICHOLAS D. ROSEN
PRIMARY EXAMINER

December 29, 2007